

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK C. WIEDNER

Appeal No. 1998-1240
Application 08/198,443¹

HEARD: January 13, 2000

Before FRANKFORT, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Mark C. Wiedner appeals from the final rejection of claims 1 through 11 and 13 through 26, all of the claims pending in the application. We affirm-in-part.

The invention relates to "basketball backboards and, more

¹ Application for patent filed February 18, 1994.

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specifically, to a removable basketball backboard cover"

(specification, page 1). A copy of the appealed claims appears in Appendix A of the appellant's main brief (Paper No. 10).

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Tompkins	663,306	Dec. 4, 1900
Mosgoffian	2,048,461	Jul. 21, 1936
Johnson	2,052,771	Sept. 1,
1936	Bardin	2,434,784
20, 1948		Jan.
Puste	2,652,875	Sept. 22, 1953
Henrich	2,704,563	Mar. 22, 1955
Woodruff, Sr. (Woodruff)	2,764,765	Oct. 2, 1956
Hirsch	3,622,155	Nov. 23, 1971
Anglin et al. (Anglin)	5,018,564	May. 28, 1991
Wetzel	5,120,054	Jun. 9, 1992
Zaruba	5,224,699	Jul. 6, 1993

Claims 1 through 11 and 13 through 26 stand rejected as follows:

a) claims 1 through 3, 6, 8 and 11 under 35 U.S.C. § 102(b) as being anticipated by Puste;

b) claim 4 under 35 U.S.C. § 103 as being unpatentable over Puste in view of Anglin;

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c) claim 5 under 35 U.S.C. § 103 as being unpatentable over Puste in view of Henrich;

d) claim 7 under 35 U.S.C. § 103 as being unpatentable over Puste in view of Bardin and Tompkins;

e) claim 9 under 35 U.S.C. § 103 as being unpatentable over Puste in view of Woodruff;

f) claim 10 under 35 U.S.C. § 103 as being unpatentable over Puste in view of Mosgoffian; and

g) claims 1 through 11 and 13 through 26 under 35 U.S.C. § 103 as being unpatentable over Hirsch in view of Zaruba, Wetzel, Johnson, Puste, Anglin, Bardin, Mosgoffian and Henrich.

Reference is made to the appellant's main and reply briefs (Paper Nos. 10 and 12) and to the examiner's answer (Paper No. 11) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

Puste discloses a fabric cover for a toilet tank. The cover 13 includes portions 16, 17 and 18 for respectively overlying the front, side and bottom walls of the tank 11, a

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circular opening 14 for allowing a plunger handle 15 to pass through the cover, a central notch 23' for accommodating a drain pipe 12, and tapes 21 having ends 22, 25 for tying about the rear of the tank and the drain pipe to secure the cover in place.

With regard to the standing 35 U.S.C. § 102(b) rejection of claims 1 through 3, 6, 8 and 11 as being anticipated by Puste, it is well settled that anticipation is established when a single prior art reference discloses, expressly or under principles of

inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

The explanation of the rejection in the answer (see pages 3 and 9) indicates that the examiner's determination of anticipation relies heavily on principles of inherency. The appellant contends (see pages 19 through 21 in the main brief) that the examiner's analysis is unsound because Puste does not

meet the preambular recitations in the claims (i.e., independent claims 1 and 11) calling for a removable backboard cover or the limitations in the claims (i.e., claims 1 and 11) requiring the cover to have one opening in its central portion.

As conceded by the appellant (see, for example, page 5 in the main brief), the claims in question are directed to a removable backboard cover per se, and not to the combination of a cover and a backboard. The appellant has not cogently explained, nor is it evident, why the cover disclosed by Puste is not inherently capable of use as a basketball backboard cover, thereby meeting the preambular recitations in the claims. Similarly, the appellant has not cogently explained, nor is it clear, why the central notch 23' in Puste's cover is not inherently capable of permitting a rim attached to the front face of a backboard to project therethrough as recited in the claims. Although the Puste cover does include a second opening 14, the claims do not contain any limitation which excludes or is otherwise inconsistent with this second opening. In this regard, the claims are not, as submitted by

the appellant, limited to a cover having only one opening.

Thus, the appellant's position that the subject matter recited in claims 1 through 3, 6, 8 and 11 distinguishes over the cover disclosed by Puste is not persuasive. Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of these claims.

We also shall sustain the standing 35 U.S.C. § 103 rejections of claim 4 as being unpatentable over Puste in view of Anglin, claim 5 as being unpatentable over Puste in view of Henrich, claim 7 as being unpatentable over Puste in view of Bardin and Tompkins, claim 9 as being unpatentable over Puste in view of Woodruff and claim 10 as being unpatentable over Puste in view of Mosgoffian.

These dependent claims recite various expedients for securing the claimed cover in place. The secondary references show these expedients to be conventional and well known. Their self-evident advantages justify the examiner's conclusion that it would have been obvious to modify the Puste cover to include same and belie the appellant's contention (see pages 21 through 28 in the main brief) that the proposed

reference combinations are founded on impermissible hindsight.

Finally, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 1 through 11 and 13 through 26 under 35 U.S.C. § 103 as being unpatentable over Hirsch in view of Zaruba, Wetzel, Johnson, Puste, Anglin, Bardin, Mosgoffian and Henrich.

This rejection rests on the basic combination of Hirsch, Zaruba, Wetzel and Johnson.

Hirsch discloses a basketball backboard set 10 comprising a backboard 12 and a hoop 14.

Zaruba discloses a basketball game 11 which includes a backboard 13 "to which is attached a laminated full color overlie 15 which may contain an illustration of a famous basketball player along with a trademark indicating the source of the game" (column 1, lines 61 through 64).

Wetzel discloses a basketball backboard structure 2 having a protective bumper structure 6 removably attached to its bottom and lower side edges.

Johnson discloses "a sign body [6] bearing original display matter [18] of a more or less permanent character and a flexible covering [19] bearing new display matter [20] of a special or seasonal import which is adapted to fit upon the sign body to superpose the new display matter upon the original display matter" (page 1, column 1, lines 3 through 8).

The examiner has concluded that it would have been obvious to one of ordinary skill in the art in view of the teachings of Zaruba, Wetzel and Johnson to "provide Hirsch with a removable cover carrying indicia and means to removably secure it to the backboard to permit changing the cover and indicia from time to time" (answer, page 5). Given the disparate natures of the Hirsch, Zaruba, Wetzel and Johnson disclosures, however, it is apparent that the examiner has engaged in an impermissible hindsight reconstruction of the appellant's invention by using the claims as a blueprint to pick and choose from among isolated disclosures in the prior art, a flaw which is not cured by the additional application of Puste, Anglin, Bardin, Mosgoffian and Henrich.

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In summary and for the above reasons, the decision of the examiner to reject claims 1 through 11 and 13 through 26 is affirmed with respect to claims 1 through 11 and reversed with respect to claims 13 through 26.

AFFIRMED-IN-PART

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
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